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In re Application of :  
PARKER et al. :  
U.S. Application No. 09/762,562 :  
PCT No.: PCT/US98/16521 :  
Int. Filing Date: 10 August 1998 :  
Priority Date: None :  
Attorney Docket No.: 381-23-014 :  
For: ELECTRIC ARC MONITORING :  
SYSTEM :

DECISION ON PETITION  
UNDER 37 CFR 1.47(a)

This is a decision on applicants' "PETITION UNDER 37 CFR 1.47(a)" filed 29 August 2001 to accept the application without the signature of joint inventor, Howard M. Ham. The signing joint inventors request that the above-captioned national stage application be accorded status under 37 CFR 1.47(a) without the signature of joint inventor Howard M. Ham due to their inability to "obtain the signature of Howard M. Ham, Jr., to no avail. Howard M. Haw is deceased." The required petition fee of \$130.00 (37 CFR 1.17(i)) has been submitted.

BACKGROUND

On 10 August 1998, applicants filed international application PCT/US98/16521 which claimed no priority date and designated the United States. A proper Demand was filed with the International Preliminary Examination Authority prior to the 19th month from the earliest claimed priority date. As a result, the deadline for payment of the basic national fee was to expire 30 months from the international filing date, or at midnight on 10 February 2001.

On 09 February 2001, applicants filed a transmittal for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1) and international application.

On 29 March 2001, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring an oath or declaration in compliance with 37 CFR 1.492(a) and (b).

On 29 August 2001, applicants filed: "Transmittal of Missing Requirements under 35 U.S.C. 371"; a declarations and power of attorneys signed by three of the four joint inventors; a petition under 37 CFR 1.47(a) and the requisite fee; and a petition for a three-month extension of time and the requisite fee.

## DISCUSSION

Section 409.03(c) of the Manual of Patent Examining Procedure (M.P.E.P.) states, in part:

"37 CFR 1.47 should not be considered an alternative to 37 CFR 1.42 or 35 U.S.C. 117 since the language "cannot be found or reached after diligent effort" has no reasonable application to a deceased inventor. In re Application Papers Filed September 10, 1954, 108 USPQ 340 (Comm'r Pat. 1955). See 37 CFR 1.42 and MPEP § 409.01. However, 37 CFR 1.47 does apply where a known legal representative of a deceased inventor cannot be found or reached after diligent effort, or refuses to make application. In such cases, the last known address of the legal representative must be given (see MPEP § 409.03(e))."

Additionally, a petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the non-signing joint inventor. Items (1), (3) and (4) have been satisfied.

As to item (2), petitioner states that Margaret Ham, legal representative of the deceased inventor, Howard M. Ham cannot be found or located after diligent effort. Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), **Proof of Unavailability or Refusal**, states, in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47.

Furthermore, the fact that an inventor is hospitalized and/or is not conscious is not an acceptable reason for filing under 37 CFR 1.47. 37 CFR 1.43 may be available under these circumstances. See MPEP § 409.02. Such a petition under 37 CFR 1.47 will be dismissed as inappropriate.

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included statement of facts. It is

important that the statement contain facts as opposed to conclusions.

A review of the present petition and the accompanying papers reveal that applicant has not satisfied the item (2) above, in that the applicants have not shown that a bona fide attempt was made to present the application papers, including the specification, claims, and drawings to the legal representative Margaret Ham. The petition did not indicate that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the legal representative Margaret Ham for signature as required. The mailing of a declaration and petition is not considered a complete application. Additionally, petitioner alleges that legal representative Margaret Ham cannot be found or located. Petitioner has provided a copy of the returned envelope which notes that "the forwarding order has expired." Since no other attempts to locate Margaret Ham have been noted coupled with petitioner uncertainty regarding the legal representative or heirs of the deceased inventor, additional information is requested. For example, what papers were sent to Ms. Ham, were other attempts made to locate Ms. Ham and is Ms. Ham the appropriate person to execute the declaration on behalf of the deceased inventor?

For the reasons stated above, it would not be appropriate to accept the application without the signature of legal representative Margaret Ham under 37 CFR 1.47(a) at this time.

### CONCLUSION

The petition under 37 CFR 1.47(a) is DISMISSED.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTH** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention to the PCT Legal Office.



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